

REMARKS

Applicants would like to thank Examiner Nguyen and Primary Examiner Shoap for granting the telephonic interview of July 20th, which is summarized below. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 12, 23, and 36 are currently being amended. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 1-12, 14-28, and 30-37 are now pending in this application.

The present application was originally filed on December 21, 2001 with 32 claims. On August 27, 2002, a preliminary amendment was filed in which additional claims 33-35 were added. A second preliminary amendment was filed on September 24, 2003. In the second preliminary amendment, claim 1 was amended to eliminate an ambiguity in the claim language, and new claims 36 and 37 were added.

On October 6, 2003, the Examiner issued a first Official Action. However, the Examiner had yet to receive the September 24, 2003 preliminary amendment, in which a number of the issues raised by the Examiner had already been corrected. The Examiner subsequently agreed to reexamine the claims in light of the September 24, 2003 preliminary amendment. A new Official Action was issued on December 10, 2003, vacating the October 6, 2003 Official Action.

The Office Action of December 10, 2003 rejected claims 13-15 under 35 U.S.C. § 112, second paragraph. In addition, the Examiner rejected claims 1-9, 12-21, 23-28, 31 and 33-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,768,177, issued to Thomas, in view of U.S. Patent No. 5,511,472, issued to Taylor, and U.S. Publication No. 2002/009695, in the name of Rasheed et al.

On May 20, 2004, the Examiner issued a Final Office Action. Claims 1-9, 12-21, 23-28, 31, and 33-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Taylor, Rasheed et al., and Shimizu et al. Claims 10, 11, 22, and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Taylor and Rasheed et al. and further in view of U.S. Pat. No. 6,216,354 issued to Carbone. Claims 23, 28-30, 36, and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of U.S. Pat. No. 4,309,825 issued to Geddes.

A telephonic interview was held July 20, 2004 between Mr. Marshall Brown and Mr. Matt Martin and Examiner Phong Nguyen and Primary Examiner Allan Shoap. Claim 1 was discussed. Although no agreement was reached, the Examiner stated that Claim 1 was on the right track. In addition, the Examiner clarified that he considered the templates of the present application to be dies.

Applicants are filing concurrently with this Amendment a Request for Continued Examination of the present application.

Claims 1-9, 12-21, 23-28, 31, and 33-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Taylor, Rasheed et al., and Shimizu et al. The Examiner has asserted that Thomas teaches a base with pegs which can be used as the base of an embossing system. The Examiner has stated that Taylor teaches an embossing system with an upper and lower template and that it would have been obvious to combine the teaching of Taylor with Thomas to provide a stable workplace to hold templates for embossing artworks. The Examiner has contended that Shimizu teaches the size of the upper template being slightly larger than the size of the lower template to create a pronounced embossment. The Examiner noted that the drawing process described in Shimizu is similar to the embossing process of the present invention.

Claim one has been amended to clarify certain aspects of the invention, particularly as defined in paragraphs 17 and 28 of the present application. Applicants have added the limitation

“the plurality of shapes of the upper template having an outer guide edge; and the plurality of shapes of the lower template having an outer embossing edge which protrudes beyond the outer edge of the upper template when the upper template and lower template are aligned; wherein the substantially identical shapes of the lower template and the upper template interact to thereby provide a crisp embossment.” Claim twelve has been amended to describe the lower template as having an exposed outer edge around a perimeter of the plurality of shapes when the lower template and upper template are in alignment wherein the first and second template interact to provide a crisp embossment. Claim twenty-three has been amended to further described an outer guide edge of the first template and an outer embossing edge of the second template, which interact to provide a crisp embossment. Claim thirty-six has been amended to further describe a marking instrument which interacts with the first and second templates to score the material wherein the first and second templates interact to provide a crisp embossment.

Claims 1-9, 12-21, 23-28, 31, and 33-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Taylor, Rasheed et al. and Shimizu et al. The Examiner cited Thomas as teaching a base with pegs capable of using as a base of an embossing system. The Examiner stated that “Taylor teaches an embossing apparatus having an upper and a lower template.” The combination of Thomas’ base and pegs and Taylor’s upper and lower template was viewed, by the Examiner, as an obvious combination for one skilled in the art. The Examiner relied on Rasheed et al. for the concept of textured plates. Shimizu was cited by the Examiner as teaching an upper template of slightly larger size than the lower template.

Thomas is not directed to an embossing system, but rather a children’s education device. Thomas does not disclose the use of an upper and a lower template, let alone the feature of two templates having identical shapes of differing size. Thomas also does not disclose the amended feature of an outer guide edge nor an outer embossing edge. Thomas lacks any teaching of “the plurality of shapes of the lower template having an outer embossing edge which protrudes beyond the outer edge of the upper template when the upper template and lower template are

aligned; wherein the substantially identical shapes of the lower template and the upper template interact to thereby provide a crisp embossment.” [Claim 1]

Taylor does not disclose the use of a pair of templates which have corresponding shapes of different size. Taylor does not make known any feature or features including “a plurality of shapes formed therein that align with and are substantially identical to the plurality of shapes of the lower template when the posts and the regions of the second template and the lower template are in alignment, the plurality of shapes of the lower template being smaller in size than the corresponding plurality of shapes of the upper template.” [Claim 1] Likewise, Taylor does not teach the use of an outer guide edge.

Additionally, Rasheed et al. does not disclose a pair of templates having identical shapes of different sizes. Rasheed et al. also does not disclose the templates having a guide edge nor an embossing edge. Rasheed et al. is silent as to the use of two templates to provide a crisp embossment by their interaction.

Shimizu is not directed to an embossing system, but rather to “a drawing punch for use in drawing foils in a die which converges in the direction of drawing.” Thus, the apparatus of Shimizu does not use templates, as claimed in the present invention, but rather teaches the use of dies. In addition, Shimizu teaches the use of dies which converge in the direction of drawing, not a lower template which is of a smaller size than the upper template as claimed in the present invention. Shimizu does not disclose the use of two templates to provide a crisp embossment.

Furthermore, Shimizu does not teach the use of an upper template having a guide edge nor the use of a lower template having an embossing edge. The upper die portion of Shimizu does not act as a guide edge, rather it serves to hold the foil during drawing. The lower die portion acts as a stop, restricting the range of the punch. Thus, Applicants believe that Claims 1-9, 12-21, 23-28, 31, and 33-37 are in condition for allowance.

Claims 10, 11, 22, and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Taylor and Rasheed et al. and further in view of U.S. Pat. No. 6,216,354 issued to Carbone. The Examiner applied Thomas, Taylor, and Rasheed as discussed above. In addition, the Examiner stated that Carbone “teaches providing grid pattern 18 and 20 to help orient paper between the templates correctly.”

As discussed above, Thomas, Taylor, and Rasheed et al. do not teach an embossing apparatus having an upper template of larger size than the lower template. None of the cited references teach an apparatus wherein the upper template has an outer guide edge and the lower template has an embossing edge. Furthermore, Carbone does not teach templates of different size, nor the use of an outer guide edge or an embossing edge. Carbone does not disclose the use of two templates to provide a crisp embossment. Thus, Applicants believe that Claims 10, 11, 22, and 32 are in condition for allowance.

Claims 23, 28-30, 36, and 37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of U.S. Pat. No. 4,309,825 issued to Geddes. The Examiner applied Thomas as discussed above. In addition, the Examiner stated that Geddes teaches a “first and second template for embossing a piece of paper.”

As previously discussed, Thomas does not disclose templates having identical shapes of different sizes nor an upper template having an outer guide edge nor a lower template having an embossing edge. Geddes has been cited for the feature of a first and second template. However, Geddes is directed to an apparatus where the first and second templates emboss different edges. Geddes is not directed to interacting the first and second templates to provide for a crisp embossment. Furthermore, Geddes also lacks the key features regarding size differences, identical shapes, guide edges and embossing edges. Thus, Applicants believe that Claims 23, 28-30, 36, and 37 are in condition for allowance.

Lastly, Applicants also respectfully highlight the fact that three and four references directed to different aspects of the art and for dissimilar purposes are being combined in the

Examiner's rejections. However, the Examiner has failed to identify within the patent references themselves any teaching or motivation to make these types of combinations. For example, the Examiner has cited Thomas as including a base and a plurality of pegs and being "capable of using as a base of an embossing system." However, the Examiner has not pointed to anywhere within the patent that teaches or even suggests that such a combination could be made.

Therefore, Applicants submit that, absent such teachings or suggestions, these combinations could only be made with the use of hindsight and are therefore improper. Applicants therefore respectfully request that the Examiner reconsider these combinations.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1450. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1450. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1450.

Respectfully submitted,

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